



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET N
06/635,390	07/30/84	GOLD	E 2328

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SCHERING-PLOUGH CORP.,  
PATENT DEPT., M-3-WEST  
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EXAMINER	
PHILLIPS, D	
ART UNIT	PAPER NUMBER
123	5

DATE MAILED: 09/05/85

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 7/19/85  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 day(s) from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892. 2.  Notice re Patent Drawing, PTO-948.  
3.  Notice of Art Cited by Applicant, PTO-1449 4.  Notice of Informal Patent Application, Form PTO-152  
5.  Information on How to Effect Drawing Changes, PTO-1474 6.

Part II SUMMARY OF ACTION

1.  Claims 1-31 are pending in the application.  
Of the above, claims 31 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-30 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8.  Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are  acceptable;  not acceptable (see explanation).

10.  The  proposed drawing correction and/or the  proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved.  disapproved (see explanation). However the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received

been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

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Claim 31 is withdrawn from further consideration by the Examiner as being drawn to a non-elected invention, 37 CFR 1.142(b). The oral traversal was not perfected in the response. Therefore the election is considered to be without traverse.

Claims 1-30 are rejected under 35 U.S.C. 103 as being obvious over the Hoefle et al. and Vincent et al. patents. As was stated before, the art indicates that the instant ring system with sulfur substitution has anti-hypertensive activity. The Hoefle et al. patent indicates that the alanyl substituted condensed ring nitrogen containing one carboxyl ring system has anti-hypertensive activity. It also establishes that the sulfur substitution would be expected to be equivalent as far as anti-hypertensive activity is concerned to the alanyl substituted ring. It is therefore considered that the instant claims are obvious in view of the art. The decisions cited by applicants are not in point since there is adequate basis in the references to make the combination as set forth above. It is considered that the art does provide basis for the substitution of the sulfur with the alanyl moiety in this type of ring system.

Applicants' arguments that Vincent does not teach the ring system claimed herein are not understood since applicant's parent application equates the ring systems of Vincent. Applicants have established the equivalence in their parent application and now they argue that they are not equivalent in this application. This is inconsistent and In re Skoll, 187 U.S.P.Q. 480 at 485 indicates that it is

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improper for applicants to indicate equivalency in the parent application and then in their daughter application argue non-equivalency.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE OF THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Phillips whose telephone number is (703) 557-1094. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3920.

9-1-85:cdc

*Delbert R. Phillips*  
DELBERT R. PHILLIPS  
PRIMARY EXAMINER  
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